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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,278	07/18/2003	Anne E. Spinks	99-113-US-02	2410

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EXAMINER

LONEY, DONALD J

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/623,278

**Applicant(s)**

SPINKS, ANNE E.

**Examiner**

Donald Loney

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on March 31, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat. No. 6602444 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, last line the applicant recites "said composition being essentially free of a film forming agent". This is in contrast to the recitation that the composition contains a "polyalphaolefin" since these are also film forming agents. The examiner has cited US Pat. No. 4665116 to Kornhaber et al as a teaching reference to the fact (see column 11, line 65 through column 12, line 3). Also see the Abstract of JP 08217930. The applicant has not specifically established what the film forming agent is since at page 5, lines 8 and 9 the applicant refers to them as being e.g. polyisobutylene and butyl rubber. The use of "for example" leads to other materials may also be film forming agents, of which, polyalphaolefins are, as shown above. Claim 2 contains an improper Markush group in that the recitation of "vinyl acetate" is an ester, not a polyalphaolefin polymer.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1, 2, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Paeglis et al (5569516).

Paeglis et al discloses a composition comprising up to 40 % polyalphaolefin and 10-80% adsorbent. Refer to column 5, lines 42-46 and column 8, lines 27-40. The examiner deems the polyalphaolefin as being inherently amorphous due to its low degree of crystallinity. The crystallinity is disclosed as low as 2% at column 5, lines 61 through column 6, line 16. The applicant indicates that amorphous is a low degree of crystallinity at page 4, line 16, with no numerical guidance as what "low" is. The examiner has cited US Pat. No. 4614778 to Kajiura et al as a teaching reference as to less than 40% crystallinity is considered low and amorphous alpha-olefin copolymers (see column 8, lines 4-9). With regards to claim 2, see column 5, lines 39-46. With regards to claims 12 and 13, drawn to "consisting essentially of", they are included since the applicant from page 2, line 21 of the specification is attempting to exclude polyisobutylene and butyl rubber from the recited composition using said limitation. Also, from MPEP section 2111.03, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will

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be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. Any additional materials in the prior art must be shown to materially effect the composition due to the "consisting essentially of" recitation, which allows other materials not materially affecting the composition.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paeglis et al.

The primary reference teaches the invention substantially as recited except for the flow rates per claims 3-6 and 11. See the 35 U.S.C. 102 rejection above. Paeglis et al does disclose flow rates from a different test at column 6, lines 64-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to Paeglis et al to form the composition with flow rates as recited

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motivated by the fact one would use what ever flow rate is need for a particular application. A particular application disclosed in Paeglis et al is for use in glazings (column 8, lines 61-66), which the same field the applicant uses the recited low flow melt composition in. With regards to claim 7, see column 8, lines 27-40. With respect to claims 8 and 9, one would be motivated to form the composition of the recited properties since Paeglis et al discloses the composition being used in the same filed as the applicant (i.e. glazings as indicated above). With regards to claim 10, Paeglis et al discloses the composition as used in the glazing art (column 8, line 65), therefore it would be obvious to seal an insulating glass unit (i.e. glazing) there with.

9. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Lafond (5436040) or Lancesseur (5432214) in view of McConnell et al (3954697).

Lafond discloses a composition containing a polyalphaolefin and an adsorbent. The adsorbent is 1-50% thereof. This composition is used in insulating glazing units per claim 10. Refer to the figures and column 2, lines 43-46, column 3, lines 24-33 and column 5, lines 1-52. Lafond does fail to specifically disclose the polyalphaolefins as amorphous or that they are 30-80% of the composition. Lancesseur discloses a composition containing a polyalphaolefin and adsorbent. The adsorbent is in the amount of 20-50% by weight. The amorphous polyalphaolefin is the elastomer component which is up to 8% as indicated by the applicant in the last response, filed May 5, 2006. Refer to column 1, lines 36-61. The applicant now recites 30-80% amorphous polyalphaolefin. Lanesseur does disclose an additional 50-80% polyalphaolefins, however, does not specifically disclose them as being amorphous (see column 1, lines 39-59).

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McConnel et al discloses that it is known to use low crystallinity (i.e. amorphous) polyalphaolefin polymers in a hot melt adhesive which provides good cohesive strength thereto. Refer to the Abstract and column 4, lines 1-12.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to either Lafond et al or Lancesseur et al to use an amorphous polyalphaolefin, as taught by McConnel, for the 50-80% polyalphaolefin in order to form a good cohesive strength therefrom motivated by the fact Lancesseur discloses additional polyalphaolefins, Lafond discloses polyalphaolefins and McConnel teaches the use of amorphous ones for good cohesion. The weight percent for Lafond et al would be obvious since Lancesseur teaches percents in this range and Lafond is silent thereto. With regards to the flow rates of claims 3-6 and 11 it would have been obvious to one having ordinary skill in the art to form the composition with flow rates as recited motivated by the fact one would use whatever flow rate is needed for a particular application. A particular application disclosed in Lafond et al is for use in glazings (column 8, lines 61-66), which in the same field the applicant uses the recited low flow melt composition in. With respect to claims 8 and 9, one would be motivated to form the composition of the recited properties since Lafond et al discloses the composition being used in the same field as the applicant (i.e. glazings as indicated above). With regards to claim 10, Lafond is drawn to sealing in the glazing art. With regards to claims 12 and 13, drawn to "consisting essentially of", they are included since the applicant from page 2, line 21 of the specification is attempting to exclude polyisobutylene and butyl rubber from the recited composition using said limitation. Also, from MPEP section 2111.03, for

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the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. Any additional materials in the prior art must be shown to materially effect the composition due to the "consisting essentially of" recitation, which allows other materials not materially affecting the composition.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

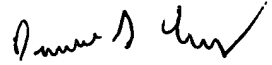
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJL:D.Loney  
08/29/06



Donald Loney  
Primary Examiner  
Art Unit 1772